

**II. Rejection Under 35 U.S.C. § 103(a)**

In the outstanding Final Office Action, the Examiner has maintained the rejection of claims 1-83 under 35 U.S.C. § 103(a) as unpatentable over European Patent No. 0 842 652 A1 to *Restle et al.* ("*Restle*") in view of U.S. Patent No. 5,135,748 to *Ziegler et al.* ("*Ziegler*") and over the *Restle/Ziegler* combination in further view of several secondary references. Applicants respectfully continue to traverse these rejections for at least the reasons of record and the additional following reasons.

The Examiner has failed to establish a *prima facie* case of obviousness because there is no motivation to combine the references cited. The Examiner bears the burden of establishing, among other things, that there exists some suggestion or motivation to modify or combine reference teachings. M.P.E.P. § 2143. Importantly, the Examiner must present a "full and reasoned explanation" of her decision, wherein the reasons supporting the decision are articulated and the decision is sound. *In re Lee*, 277 F.3d 1338, 1342 (Fed. Cir. 2002).

In the present case, the Examiner has not articulated a sound reason for combining the references. The Examiner states that "Ziegler does require the combination of both the cationic polysaccharides and quaternary ammonium functionalized phosphate esters in order to achieve the proposed enhancement of the moisture retention on skin." (Final Office Action dated February 12, 2002, page 3, lines 14-17.) There is no motivation in either *Restle* or *Ziegler*, however, that would have led one of ordinary skill in the art to combine the cationic polysaccharides or the quaternary ammonium functionalized phosphate esters of *Ziegler* with the compositions of *Restle*, let alone both components. Nonetheless, the Examiner alleges that the proposed

modification is supported by the "expectation of successfully producing a cosmetic composition with enhanced stability and moisture retention." (Office Action dated August 16, 2001, page 3, lines 15-18.) This reasoning, though perhaps sufficient to support only selecting *Ziegler*, is insufficient to support selecting *Restle* and is further insufficient to support combining *Ziegler* with *Restle*. Under the Examiner's reasoning, modifying any composition by adding the two components of *Ziegler* for the purposes taught by *Ziegler* would be obvious. Motivation to combine references, however, requires more—a "clear and particular" motivation to combine. *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). Here, the Examiner has not articulated any reason to combine the two components of *Ziegler* with the compositions of *Restle*.

Notwithstanding the fact that the Examiner has not satisfied her burden of establishing a *prima facie* case of obviousness, Applicants maintain their position that combining *Ziegler's* entire combination with the compositions of *Restle* would not render obvious the claimed invention because *Ziegler* is directed to emulsions, not nanoemulsions like *Restle*. As shown in the paragraph bridging pages 1-2 of the specification, Applicants were aware of the differences between different emulsions, here, between a nano-emulsion and micro-emulsions, and improved on the properties of a nano-emulsion. *Ziegler* does not even recognize the differences between such emulsions, let alone teach or suggest ways to improve stability and cosmetic properties of nano-emulsions.

Applicants respectfully submit that combining components of an emulsion (*Restle*) with components of a nanoemulsion (*Ziegler*) would not have been obvious, as

FINNEGAN  
HENDERSON  
FARABOW  
GARRETT &  
DUNNER LLP

1300 I Street, NW  
Washington, DC 20005  
202.408.4000  
Fax 202.408.4400  
www.finnegan.com

serendipity and guesswork are necessarily involved. In moving from the prior art to the claimed invention, one cannot base a determination of obviousness on what the skilled person might try or find obvious *to try*. Rather, the proper test requires determining what the prior art would have led the skilled person *to do*. The Federal Circuit has given some examples of what would constitute an "obvious to try" modification based on the prior art. See *In re O'Farrell*, 853 F.2d 894, 7 U.S.P.Q.2d 1673 (Fed. Cir. 1988). For example, what was 'obvious to try' was to explore a new technology or general approach that seemed to be a promising field of experimentation, where the prior art gave only general guidance as to the particular form of the claimed invention or how to achieve it." *Id* at 903, 7 U.S.P.Q.2d at 1681 (citations omitted). In the present case, the prior art, at best, gave general guidance to use components in generic emulsions (not nanoemulsions) in cosmetic compositions. Thus, while the prior art may make it obvious to try the components suggested therein to arrive at the claimed invention, such an obvious to try standard does not support a rejection under Section 103.

The Examiner attempts to provide evidence that "the cationic surfactants used in typical emulsions are also employed in both Restle's and applicants' nanoemulsions." (Final Office Action dated February 12, 2002, page 4, lines 18-19.) The reference cited, however, (U.S. Patent No. 6,120,757 to *Dubief et al.*) discloses a broad teaching of "emulsions of oil-in-water type, gels and cream-gels" and emulsions "in the form of a simple or complex emulsion (O/W, W/O, O/W/O or W/DW)." (*Dubief*, col. 6, lines 17-23.) Like *Ziegler*, this reference does not clearly and unequivocally disclose its cationic surfactants in nanoemulsions as claimed. Thus, *Dubief* fails to suffice as evidence that the cationic surfactants are known to be used in nanoemulsions.

FINNEGAN  
HENDERSON  
FARABOW  
GARRETT &  
DUNNER LLP

1300 I Street, NW  
Washington, DC 20005  
202.408.4000  
Fax 202.408.4400  
www.finnegan.com

The Examiner additionally relies on *Ex Parte Obiaya*, 227 U.S.P.Q. 58 (Bd. Pat. App. & Interf. 1985) for the proposition that the “examiner’s proposed reason to combine the references do not have to coincide with the applicants’ reason to come up with the instant invention, so long as the proposed motivation is found in the references and not from applicants’ disclosure.” (Final Office Action dated February 12, 2002, page 4, lines 7-10.) The case cited by the Examiner, which recites that “[t]he fact that [applicant] has recognized another advantage which would flow naturally *from following the suggestion of the prior art* cannot be the basis for patentability when the differences would otherwise be obvious,” presupposes that there is a suggestion present in the cited references and that the Examiner is justified in relying on such a substitution. *Obiaya*, 227 U.S.P.Q. at 60 (emphasis supplied). As is explained above, however, there is no such suggestion present in the references cited against the instant application.

Rather, it is clear that, with the aid of Applicants’ specification as a template, the Examiner has engaged in improper hindsight reconstruction by piecing together isolated and non-combinable sections of the references in an attempt to reconstruct Applicants’ invention. Because the Examiner has included knowledge gleaned only from Applicant’s disclosure—the knowledge of *combining* the elements as Applicant has combined them, this rejection is improper.

As the Examiner has failed to make the requisite clear and particular showing of a motivation to combine the references cited, Applicants respectfully submit that the rejection under § 103 is improper and should be withdrawn. Further, as the Examiner has failed to satisfy her burden under 35 U.S.C. § 103, with respect to the primary combination of references, *i.e.*, *Restle/Ziegler*, and as the secondary references do not

FINNEGAN  
HENDERSON  
FARABOW  
GARRETT &  
DUNNER LLP

1300 I Street, NW  
Washington, DC 20005  
202.408.4000  
Fax 202.408.4400  
www.finnegan.com

cure the deficiencies of this combination, the additional rejections relying primarily on *Restle/Ziegler* are improper.

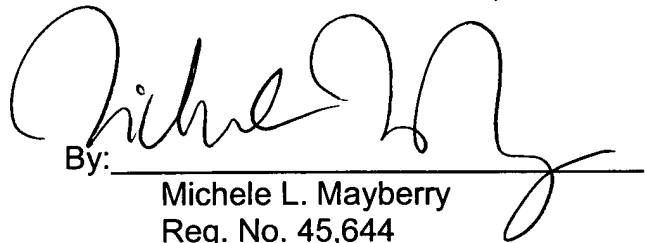
**III. Conclusion**

In view of the foregoing remarks, Applicants submit that the claimed invention is not obvious in light of the references cited against this application. Applicants therefore request the Examiner's reconsideration of the application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

  
By: \_\_\_\_\_  
Michele L. Mayberry  
Reg. No. 45,644

Dated: May 30, 2002

FINNEGAN  
HENDERSON  
FARABOW  
GARRETT &  
DUNNER LLP

1300 I Street, NW  
Washington, DC 20005  
202.408.4000  
Fax 202.408.4400  
www.finnegan.com